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APPLICATION NO	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09/697,379	10/26/2000	Jonathan Edward Lightner	BB-1043-US-NA-DIV	8713

890 01/30/2002
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EXAMINER
MCHLWAIN, ELIZABETH E

ART UNIT	PAPER NUMBER
1638	

DATE MAILED 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/697,379	LIGHTNER ET AL.
	Examiner Elizabeth McElwain	Art Unit 1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will by statute cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 October 2000.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1, 9, 10, 13, 15-20 and 24-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to
- 8) Claim(s) 1, 9, 10, 13, 15-20, AND 24-59 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f)
- a) All b) Some * c) None of:
- 1) Certified copies of the priority documents have been received
- 2) Certified copies of the priority documents have been received in Application No. _____
- 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))
See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
- a) The translation of the foreign language provisional application has been received
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) Interview Summary (PTO-413) Paper No(s) _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other

The Preliminary Amendment filed October 26, 2000 has been entered.

Claims 2-8, 11, 12, 14 and 21-23 have been cancelled.

Claims 9, 10, 15, 16, 18-20 and 27 have been amended.

Claims 28-59 are newly submitted.

5 Claims 1, 9, 10, 13, 15-20 and 24-59 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 33-44, drawn to genes and tranformed plants and seeds, classified in class 536, subclass 23.6, for example.

10 II. Claim 9 and 31 drawn to soybean oil, classified in class 426, subclass 601, for example.

III. Claims 10, 34 and 45, drawn to a method of producing oil by transforming a plant, classified in class 800, subclass 281, for example.

15 IV. Claim 13, drawn to a method of isolating nucleic acids, classified in class 435, subclass 89, for example.

V. Claim 15, 46, 47 and 50 drawn to a method for altering fatty acid compositions by making a cross with a mutant line, classified in class 800, subclass 281, for example.

20 VI. Claims 16, 17, 48 and 49, drawn to a method for reducing polyunsaturated fatty acids in rapeseed oil, classified in class 800, subclass 281, for example.

- VII. Claims 18, 51 and 52, drawn to a method for reducing saturated fatty acids in rapeseed seeds, classified in class 800, subclass 264, for example.
- VIII. Claim 19, 53 and 54, drawn to a method of reducing polyunsaturated fatty acids in soybean oil, classified in class 800, subclass 264, for example.
- 5 IX. Claims 20, 55 and 56, drawn to a method of reducing saturated fatty acids in soybean seeds, classified in class 800, subclass 264, for example.
- X. Claim 24, drawn to a soybean plant with seed palmitic acid of 6.7% or lower of total fatty acid, classified in class 800, subclass 312, for example.
- 10 XI. Claim 25, drawn to a soybean plant with seed stearic acid of 2.1% or lower of total fatty acid, classified in class 800, subclass 312, for example.
- XII. Claim 26, drawn to a soybean plant with combined seed palmitic acid and seed stearic acid of 9.2% or lower of total fatty acid, classified in class 800, subclass 312, for example.
- 15 XIII. Claim 27, drawn to oil obtained from one of the plants of claims 21-26, classified in class 426, subclass 601, for example.
- XIV. Claim 28, drawn to a method of producing seed oil, classified in class 426, subclass 601, for example.
- XIV. Claim 29, drawn to a product of a method of producing seed oil, classified in class 426, subclass 601, for example.
- 20 XVI. Claims 30 and 32, drawn to canola oil, classified in class 426, subclass 601, for example.

XVII. Claim 57, drawn to soybean oil with oleic acid of at least 75%,

classified in class 426, subclass 601, for example.

XVIII. Claim 58 and 59, drawn to soybean oil with oleic acid of at least 70% and

linoleic acid less than 14%, classified in class 426, subclass 601, for example.

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The inventions are distinct, each from the other because:

The inventions of Groups I-XVIII are distinct methods and products given that each method requires different method steps and different components, and each results in the production and isolation of chemically and structurally distinct products. The genes of Group I can be used for other purposes than to modify fatty acids in a plant, such as for the synthesis of the enzyme, and therefore can be used in methods other than transformation of plants. The transformed plants of Group I are distinct from the plants of Groups X- XII, are distinct one from another, as each is distinct chemically and structurally and each can be made by alternative methods, such as by mutation or breeding. In addition, the plants of Groups I and X-XII are distinct products from the oil and products of Groups II, XIII, and XV-XVIII, wherein each differs in composition and structurally and each can be made and used independently of each of the others. Furthermore, the methods of Groups III-IX and XIV each differ one from the other in that they use different starting materials require different method steps and result in different products. In addition, the methods of Groups III-IX and XIV are not required for the production of the claimed products, as each product can be made by an alternative method using different starting materials and different method steps, and one is not

required by the other. Thus the inventions of Groups I-XVIII are each capable of being separately made, independently used and the patentability of one would not render the other obvious or unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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December 15, 2001

FEB 1 2002 WAIN
USPTO 308-0196
Mr. [REDACTED]
[REDACTED]